REMARKS

The present application was filed on February 15, 2001, with claims 1-6, and claims the priority of U.S. Provisional Patent Application Serial No. 60/159,162 filed October 13, 1999. Claims 1-6 remain pending in the present application. Claim 1 is the only independent claim.

Claims 1-4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,706,097 (hereinafter "Schelling") in view of U.S. Patent No. 6,686,958 (hereinafter "Watanabe").

Claim 5 stands rejected under §103(a) as being unpatentable over Schelling and Watanabe in view of U.S. Patent No. 6,445,412 (hereinafter "Shiohara").

Claim 6 stands rejected under §103(a) as being unpatentable over Schelling and Watanabe in view of U.S. Patent No. 5,848,420 (hereinafter "Xu").

In this response, Applicants traverse the §103(a) rejections. Applicants respectfully request reconsideration of the present application in view of the remarks below.

A proper *prima facie* case of obviousness requires that the cited references when combined must teach or suggest all the claim limitations, and that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references or to modify the reference teachings. See Manual of Patent Examining Procedure (MPEP), Eighth Edition, August 2001, §706.02(j).

Applicants submit that the Examiner has failed to establish a proper *prima facie* case of obviousness in the §103(a) rejections of claims 1 to 6, in that the proposed combinations of references, even if assumed to be combinable, fail to teach or suggest all the claim limitations, and in that no cogent motivation has been identified for combining the references or modifying the reference teachings to reach the claimed invention.

Independent claim 1 is directed to a method for accessing at least one image file transferred from a digital camera to a host computer by producing icons representative of portions of each image file. The image file includes a digital image and at least one audio data segment. The method includes, among other steps, the steps

of coupling a digital camera memory to a host computer so that the host computer identifies the image file and recognizes the presence of the corresponding digital image and audio data segment in the memory, and producing at least two icons which are provided on a display associated with the host computer and which respectively represent the digital image and the audio data segment. The digital image icon or the audio data segment icon may be selectively accessed to cause the transfer of the digital image or the audio data segment from the memory to the host computer for access by a user.

It is important to note that claim 1 calls for production, on a display associated with the host computer, of at least two icons which respectively represent the digital image of the image file and the audio data segment of the image file. Thus, it is abundantly clear that one of the icons corresponds to the digital image of the image file, and another one of the icons corresponds to the audio data segment of the image file. In other words, there are separate icons for the respective digital image and audio data segment of the image file. In the final Office Action, at page 3, paragraph 4, the Examiner argues that claim 1 does not recite separate icons for the respective digital image and audio data segment of an image file. Such an argument is contrary to the explicit language of the claim, and is believed to be erroneous. As noted above, the claim expressly states that there are at least two icons which respectively represent the digital image and the audio data segment. It is a direct and irrefutable consequence of this recitation that there are separate icons for the digital image and the audio data segment.

In an illustrative embodiment of the invention, as described at page 14, lines 4-25, of the specification, a digital camera 10 comprises a removable memory card 30 that stores a captured image file comprising a digital image and an audio data segment. The digital camera 10 is connected to a host computer 40 via an interface cable 36. The host computer 40 identifies the captured image file stored in the removable memory card 30 and recognizes the presence of the associated digital image and audio data segment.

FIG. 3B shows an example of a pair of icons corresponding to an image file generally denoted as P0000047. It can be seen that there are two icons which

respectively represent the digital image of the image file P0000047 and the audio data segment of the image file P0000047. More specifically, the icon labeled P0000047.jpg represents the digital image, and the icon labeled P0000047.wav represents the audio data segment. Thus, separate icons are used to denote the respective digital image and audio data segment of the image file P0000047. Actuation of a given one of the two icons in this pair will cause the transfer of the corresponding digital image or audio data segment from the memory card 30 of the digital camera 10 to the host computer 40 for access by a user. See the specification at, for example, page 14, lines 12-19.

The Examiner argues that the limitations of claim 1 are met by the combined teachings of Schelling and Watanabe. For the reasons identified below, Applicants respectfully disagree.

The collective teachings of Schelling and Watanabe fail to meet the limitations of claim 1. More specifically, the collective teachings of these references fail to teach or suggest a host computer that recognizes the presence of both a digital image and an audio data segment in a given image file stored in a digital camera memory, and produces separate icons on its display for the digital image and the audio data segment. The Examiner relies on the icons 28, 30 and the display on CRT 53 in FIGS. 1 and 3 of Schelling, in combination with the "drag and drop" method of FIG. 8 of Watanabe. However, there is no provision in either Schelling or Watanabe for the claimed arrangement in which the host computer recognizes the presence of both a digital image and an audio data segment in a given image file stored in a digital camera memory, and produces separate transfer-causing icons as claimed.

As indicated in Schelling at column 2, lines 59-64, the icons 28 and 30 are simply "type indicator" icons of an index print, that is, icons which are assigned to indicate the type of files that are present in a given data file listed on an index print. The Examiner at page 3, paragraph 5, of the June 21, 2004 Office Action states as follows:

> However, Schelling et al. do not disclose using an icon to select an image or an audio file for transfer to the host computer.

Applicants agree with the above-quoted statement, but further assert that the type indicator icons of Schelling are for purposes of providing a visual indication only, and cannot be selectively accessed to cause the transfer of any particular file from a memory to a host computer as claimed. This is readily apparent from the fact that the type indicator icons are explicitly described in Schelling as being elements of an index print, and not activatable icons of a display. See Schelling at, for example, column 2, lines 59-64. The fact that Schelling in FIG. 3 shows an index print being composed on a CRT 53 of a computer 50 does not change the fact that the type indicator icons are elements of an index print, for printing on a printer 54, and not icons which if accessed will cause the transfer of a still image or sound segment. See Schelling at column 3, lines 37-39, and column 3, line 66, to column 4, line 4. In this portion of Schelling, it is disclosed that an operator of the computer 50 must manually enter the type indicators corresponding to icons 28 and 30:

> The operator, via an input device such as a keyboard 52, selects images from the data files for making thumbnail images and generates text for subject matter descriptors. The operator appends an index code and a type indicator to each subject matter descriptor to generate the index images, and arranges the index images for display on a CRT 53. When the index print 10 has been composed, the operator prints it on a printer 54, such as a thermal printer, connected to the PC 50.

This is believed to be a direct teaching away from the claimed invention, which as indicated above calls for the host computer to recognize the presence of both a digital image and an audio data segment in a given image file stored in a digital camera memory, and to produce separate icons on its display for the digital image and the audio data segment. The type indicator icons, such as icons 28 and 30 in FIG. 1 of Schelling, are not icons which can be accessed to cause transfer of the corresponding files.

The Examiner argues that combination of the Schelling teachings with those of Watanabe will result in the claimed invention. However, as noted above, the icons 28 and 30 of Schelling relied on by the Examiner are simply visual indication

icons of an index print, and not transfer-causing icons which when accessed will result in file transfer. The FIG. 8 portion of Watanabe relied on by the Examiner simply indicates that files can be transferred by dragging and dropping associated icons, and fails to overcome the fundamental deficiencies of Schelling as applied to claim 1. That is, there is no teaching in Watanabe regarding the claimed host computer recognizing the presence of both a digital image and an audio data segment in a given image file stored in a digital camera memory, and producing separate icons on its display for the digital image and the audio data segment. Elements 33 and 42 in FIG. 8 of Watanabe are described as "image data," and thus it may reasonably be expected that only a single icon 33 or 42 would be used for a given image file, rather than separate transfer-causing icons for the respective digital image and audio data segment of the given image file as in the claimed invention. The Watanabe reference, like Schelling, also appears to teach away from the particular limitations of the claimed invention.

Accordingly, it is believed that the combined teachings of Schelling and Watanabe fail to meet the limitations of claim 1 relating to host computer recognition of both a digital image and an audio data segment in a given image file, and production of separate icons for the digital image and the audio data segment of the given image file. The proposed combination simply fails to teach or suggest the claimed production of two icons for the respective digital image and audio data segment of an image file, with the accessing of a given one of the icons causing transfer of the corresponding digital image or audio data segment to a host computer.

Inasmuch as claim 1 includes limitations not taught or suggested by the combined teachings of Schelling and Watanabe, the Examiner has failed to establish a *prima facie* case of obviousness for this claim.

Also, as indicated previously, the Examiner has failed to identify a cogent motivation for combining the Schelling and Watanabe references or modifying the reference teachings to reach the claimed invention.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination "must be based on objective evidence of record" and that "this precedent has been reinforced in myriad decisions, and cannot be dispensed with." In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir.

2002). Moreover, the Federal Circuit has stated that "conclusory statements" by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved "on subjective belief and unknown authority." Id. at 1343-1344. There has been no showing in the present §103(a) rejection of objective evidence of record that would motivate one skilled in the art to combine the Schelling and Watanabe references to produce the particular limitations in question.

More specifically, the Examiner states as follows in the June 21, 2004 Office Action at page 4, first full paragraph, regarding independent claim 1 and the proposed combination of the Schelling and Watanabe references:

> It would have been obvious to one of ordinary skill in the art at the time of invention to combine the "drag and drop" method of Watanabe et al. with the invention of Schilling [sic] et al. to create a system of allowing the user select [sic] which images or audio clips to transfer from the memory by selecting the corresponding thumbnail to a host computer for the benefit of organizing the images and audio clips on the host computer by thumbnail while freeing limited storage of the camera.

Applicants submit that this statement is a subjective and conclusory statement of obviousness, and insufficient to support the proposed combination of the reference teachings. Also, as indicated previously, Schelling teaches the use of type indicator icons in an index print, and fails to teach or suggest transfer-causing icons, while Watanabe teaches the use of a single icon for a given image file. Thus, both Schelling and Watanabe not only fail to motivate the proposed combination, but actively teach away from it.

In the final Office Action, at page 5, last paragraph, to page 6, first paragraph, the Examiner further relies on the teachings in Watanabe at column 6, lines 64-67, and column 7, lines 21-23. These portions of Watanabe provide as follows:

> Through the operation above, the image data displayed in the window can be scrolled in the upward or downward direction by the amount of three frames of images. The user is allowed to select and review merely the necessary image data without copying the entire data stored in the unit (1) to the memory (3).
>
> . . .
>
> The data having the same content as those copied in the device 28 and stored in memory (2) or (3) may be erased as necessary.

These relied-upon portions do not motivate combination of Watanabe with an index print system such as Schelling, or vice versa. Instead, they simply indicate features of the Watanabe arrangement with regard to selection of image data generally. There is no reference to index prints, or desirability of modification of an index print system such as Schelling to meet the claimed arrangement.

It therefore appears that the Examiner in formulating the §103(a) rejection of independent claim 1 over Schelling and Watanabe has undertaken a piecemeal reconstruction of the claimed invention based upon impermissible hindsight, given the benefit of the disclosure provided by Applicants.

The §103(a) rejection of claim 1 over the proposed combination of Schelling and Watanabe is believed to be improper, and should be withdrawn.

Dependent claims 2-6 are believed allowable for at least the reasons identified above with regard to independent claim 1. The Shiohara and Xu references cited by the Examiner fail to supplemental the fundamental deficiencies of the proposed combination of references as applied to the independent claim. In addition, the Examiner provides only conclusory statements of motivation for combining Shiohara or Xu with Schelling and Watanabe, and thus fails to establish a proper *prima facie* case for the additional combinations. See page 5, paragraph 3, and page 6, last paragraph, to page 7, first paragraph, of the June 21, 2004 Office Action.

In view of the foregoing, it is believed that the claims in the application are allowable over the prior art and such allowance is respectfully requested.

As indicated previously, a Notice of Appeal is submitted concurrently herewith.

The Commissioner is hereby authorized to charge any fees in connection with this communication to Eastman Kodak Company Deposit Account No. 05-0225. ***A duplicate copy of this communication is enclosed.***

Respectfully submitted,

Pamela R. Crocker
Attorney for Applicant(s)
Registration No. 42,447

PRC:cjm
Telephone: (585) 477-0553
Facsimile: (585) 477-4646

Enclosures: Notice of Appeal